

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Stefan HOLZ et al.

Serial No. 10/649,778

Group Art Unit: 2614

Confirmation No. 5851

Filed: August 28, 2003

Examiner: ESCALANTE, OVIDIO

For: MANAGING INCOMING CALLS AND/OR MESSAGES IN A COMMUNICATIONS
SYSTEM

Mail Stop - Appeal Brief - Patents
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

APPELLANTS' BRIEF IN REPLY UNDER 37 C.F.R. § 41.41

Dear Sir:

In response to the Examiner's Answer mailed September 12, 2007 in the above-identified application, Appellants submit this Reply Brief.

(9) GROUNDS OF REJECTION

The grounds of rejection listed in the Examiner's Answer at pages 3-7 are substantially similar to those that were listed in the final Office Action mailed January 5, 2007, with the addition of the following paragraph at page 4, lines 3-10, and again at page 5, lines 13-19 of the Examiner's Answer:

In Khakoo, a user (message recipient) is able to manually register his presence status, and the presence status, either present (available status), or away (unavailable status) is therefore selectable by the user for activation. If the user selects (and registers) the presence status as away, then the unavailable status is activated, and incoming messages are handled accordingly as shown in figure 3, steps 360-370. If the user selects the presence status as present, then the available status is activated and incoming messages are handled accordingly as shown in figure 3, steps 315-350.

To the contrary, no description appears in Khakoo of a user manually registering his presence status as away (unavailable status). In Khakoo, rather, manual registration by the user updates the presence and device address *entries*, not his presence *status*. This is to be contrasted with, for example, independent claim 1, in which the user's availability status is "selectable for activation by the predetermined recipient of the call and/or message." In particular, as described at paragraph [0021]:

The instant message delivery server 100 updates the presence and device address entries based on the automatic detection of the presence of the user or by a process of manual registration by the user, in any known manner.

Nor is there any description in Khakoo of an unavailable status being activated if the user selects (and registers) a presence status as away, contrary to the Examiner's assertion. In Khakoo, rather, the instant message delivery server 100 performs a *test* during step 310 to determine if the recipient is available. This is to be contrasted with, for example, independent claim 1, in which the user's availability status is "selectable for activation by the predetermined recipient of the call and/or message." In particular, as described at paragraph [0022]:

The instant message delivery server 100 performs a test during step 310 to determine if the recipient is available.

In Khakoo, moreover, even if the instant message delivery server 100 determines the recipient is unavailable, the speech is delivered as a voice mail message (i.e., a speech file) to the retrieved voice mailbox address during step 370. In particular, as described at paragraph [0024]:

If, however, it was determined during step 310 that the user is unavailable, then the instant message delivery server 100 converts the text instant message to speech during step 360 using the text-to-speech converter 125. The presence database 200 is accessed during step 365 to determine the address of the voice mailbox and the speech is delivered as a voice mail message (i.e., a speech file) to the retrieved voice mailbox address during step 370.

Thus, in Khakoo, the user is only unavailable at a *particular* device. The user is still available at another device, if the instant message delivery server 100 *determines* the user to be available at the other device. This is to be contrasted with, for example, independent claim 1, in which the user's availability status is "selectable for activation by the predetermined recipient of the call and/or message."

The remainder of the grounds of rejection have been addressed already in the Appeal Brief.

(10) RESPONSE TO ARGUMENTS

1. Response to argument that independent claims 1 and 3-10 are not anticipated by Khakoo.

A. The Examiner asserts at page 8 of the Examiner's Answer, lines 10-13, that:

However, Khakoo teaches that the presence and device address information are entered through a process of manual registration by the user (message recipient) in any known manner (paragraph 0021). Thus the message delivery server is always able to determine whether a user is available (or not).

Since, as noted by the Examiner, the message *delivery* server in Khakoo is always able to determine whether a user is available, the user's availability status is not "selectable for activation by the predetermined recipient of the call and/or message," as recited in, for example, independent claim 1. The availability of the user to receive instant messages in Khakoo, rather, is determined completely by the user's *presence* on the instant message delivery server 100, not by any selection on the part of the user. In Khakoo, if the user is determined to be *present* by the instant message delivery server 100, then the user is *available*. In particular, as described at paragraph [0021]:

Thus, the instant message delivery server 100 is always able to determine whether a user is available.

This is to be contrasted with, for example, independent claim 1, in which the user's availability status is "selectable for activation by the predetermined recipient of the call and/or message."

B. The Examiner asserts at page 8 of the Examiner's Answer, lines 13 and 14, that:

As stated in the rejection above, the user selects (and registers or enters) his presence as either "away" (figure 2) or "present" (paragraphs 0020-0021).

The fifth clause of independent claim 1, however, recites the *availability* status, not simply the *presence* of the user. Thus, even if the user were to select (and register or enter) his presence as either "away" (figure 2) or "present", as asserted by the Examiner, that still would not amount to the user's *availability status* being "selectable for activation by the predetermined recipient of the call and/or message," as recited in, for example, independent claim 1. Since the user's availability status is "selectable for activation by the predetermined recipient of the call and/or message," as recited in independent claim 1, a user can be present at a device, but unavailable to receive a call or a message. In Khakoo, on the other hand, if the user is determined to be present, then the user is available.

C. The Examiner asserts at page 8 of the Examiner's Answer, lines 15-19, that:

When the "away" presence status is selected by the user, an unavailable status (of the user) is activated (figure 3, steps 310, 360-370), whereas when the "present" presence status is selected, an available status is activated (figure 3, steps 310-350). Therefore, Khakoo teaches that an availability status (available or unavailable) is selectable by a user for activation.

To the contrary, no description appears in Khakoo of a user selecting his presence status as away, nor of an unavailable status being activated. In Khakoo, rather, manual registration by the user updates the presence and device address *entries*, not his presence *status*, and no mention of a presence status being selected *by the user* as away appears in Khakoo at all. In particular, as described at paragraph [0021]:

The instant message delivery server 100 updates the presence and device address entries based on the automatic detection of the presence of the user or by a process of manual registration by the user, in any known manner.

Furthermore, in Khakoo, the instant message delivery server 100 performs a *test* during step 310 to determine if the recipient is available. In particular, as described at paragraph [0022]:

The instant message delivery server 100 performs a test during step 310 to determine if the recipient is available.

In Khakoo, moreover, even if the instant message delivery server 100 determines the recipient is unavailable, the speech is delivered as a voice mail message (i.e., a speech file) to

the retrieved voice mailbox address during step 370. In particular, as described at paragraph [0024]:

If, however, it was determined during step 310 that the user is unavailable, then the instant message delivery server 100 converts the text instant message to speech during step 360 using the text-to-speech converter 125. The presence database 200 is accessed during step 365 to determine the address of the voice mailbox and the speech is delivered as a voice mail message (i.e., a speech file) to the retrieved voice mailbox address during step 370.

Thus, in Khakoo, the user is only unavailable at a *particular* device. The user is still available at another device, if the instant message delivery server 100 *determines* the user to be available at the other device. This is to be contrasted with, for example, independent claim 1, in which the user's availability status is "selectable for activation by the predetermined recipient of the call and/or message."

2. Response to argument that dependent claims 5 and 8 are patentable over Khakoo in view of Tiliks.

The Examiner asserts at page 9 of the Examiner's Answer, lines 1 and 2, that:

No further argument is presented by the appellant except the ones for the independent claims 1, 9, and 10 stated above.

The Appellants, to the contrary, presented two further arguments in favor of the patentability of dependent claims 5 and 8 over Khakoo in view of Tiliks. First, that neither Khakoo nor Tiliks, nor their combination, disclose all of the features of dependent claims 5 and 8, and second, that the Examiner has not made out a prima facie case of obviousness with respect to the combination of Khakoo in view of Tiliks proposed by the Examiner.

Application Serial No. 10/649,778

Appellant's Reply Brief under 37 C.F.R. § 41.41 dated November 12, 2007

Reply to Examiner's Answer mailed September 12, 2007

**CONTINGENT AUTHORIZATION TO CHARGE DEPOSIT ACCOUNT AND CONTINGENT
PETITION FOR EXTENSION OF TIME**

Appellants hereby petition for any extension of time that may be required to maintain the pendency of this case, and any required fee for such extension is to be charged to Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

Date: 12/20/07

By: 

Thomas E. McKiernan
Registration No. 37,889

1201 New York Avenue, NW, 7th Floor
Washington, D.C. 20005
Telephone: (202) 434-1500
Facsimile: (202) 434-1501